



IFW  
17609 (AP)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of  
DAVID W. OLD, et. al.

Date: March 17, 2005

Serial No: 10/652,634

Group Art Unit: 1626

Filed: August 28, 2003

Examiner: Shiao, Rei Tsang

For: CYCLOHEXYL PROSTAGLANDIN  
ANALOGS AS EP4-RECEPTOR AGONISTS

Confirmation No. 1835

*for fee only*

REPLY UNDER 37 CFR § 1.111

Mail Stop: Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

The Office Action of May 17, 2005 has been received and carefully studied. In response, Applicants amend the application to conform to the requirements of the Office action, and respectfully request that the Office reconsider the rejection.

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE  
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COMMISSIONER OF PATENTS AND TRADEMARKS  
ALEXANDRIA, VA 22313-1450  
WASHINGTON, D.C. 20531 ON 6/3/2005

*Bonnie Ferguson*  
Attorney for Applicant  
6/3/2005  
Date

REMARKS

Claims 14 and 21 are amended herein.  
Claims 31-34 are cancelled.  
Claims 35 and 36 are new.

**Claim Rejections- 35 U.S.C. § 112**

The pending claims were rejected under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the independent claims 14 and 21 failed to define R<sup>4</sup>. Applicants apologize for this oversight, and the newly amended claims 14 and 21 define R<sup>4</sup> as defined in the specification and in the original claims. Thus, applicants believe that the statute is now satisfied.

**Objection**

It is Applicants understanding Z in the amended claims was broader than the elected subject matter. The claims have been amended such that Z is "benzothiophenyl or substituted benzothiophenyl." Applicants believe that this is what the Office Action has required. However, if this is not satisfactory, Applicants request that the Examiner contact the agent by phone so that the claims can be corrected to conform to this requirement. Applicants also request that Examiner contact the agent by phone if Z has been narrowed more than the restriction requires.

Since claim 31 has been deleted, the objection due to the typographical error is now moot.

Claims 35 and 36 are supported in the specification (pp. 11-12), and the non-elected compounds have been removed.

Please use Deposit Account 01-0885 for any fees or credits related to this response.

Respectfully submitted,



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Date: June 3, 2005

Please send all inquires to:  
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